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This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

--- SUPPLEMENTAL OFFICE ACTION ---

This application has been examined Responsive to communication filed on _____ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 6 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892. 2. Notice re Patent Drawing, PTO-948.
3. Notice of Art Cited by Applicant, PTO-1449. 4. Notice of Informal Patent Application, Form PTO-152.
5. Information on How to Effect Drawing Changes, PTO-1474. 6. _____

Part II SUMMARY OF ACTION

1. Claims 1-5 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. Claims _____ have been cancelled.

3. Claims _____ are allowed.

4. Claims 1-5 are rejected.

5. Claims _____ are objected to.

6. Claims _____ are subject to restriction or election requirement.

7. This application has been filed with informal drawings under 37 C.F.R. 1.65 which are acceptable for examination purposes.

8. Formal drawings are required in response to this Office action.

9. The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.64 these drawings are acceptable. not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10. The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been approved by the examiner. disapproved by the examiner (see explanation).

11. The proposed drawing correction, filed on _____, has been approved. disapproved (see explanation).

12. Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has been received not been received been filed in parent application, serial no. _____; filed on _____

13. Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. Other

15. This is a Supplemental Office action. This Office action supplements the last Office action which was mailed on September 30, 1991. This Office action incorporates all those previous grounds of rejections herein, by way of reference to the last Office action. All rejections set forth in the prior Office action remain outstanding and must be responded to by Applicant. One new ground of rejection is set forth herein below.

The time for response to the previous Office action and this Office action will be based on the mailing date of this Office action. Applicant has a three month shortened statutory time period to respond to both Office actions based on the mailing date of this Supplemental Office action.

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

"A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent."

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States."

17. The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this Office action:

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the

differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person."

18. Claim 1 is rejected under 35 U.S.C. § 102 (a) or (b) as being anticipated by, or in the alternative, under 35 U.S.C. § 103 as obvious over Ono et al..

Ono et al. discloses one peptide specie which falls within the scope of Applicant's generic claim. The specie disclosed in cyclo(Leu-Lys-Leu-D-Leu-Leu)₂. This peptide is ten amino acids long, is cyclic, and has stretches of four leucines and one lysine. The peptide is admixed with phospholipid. See page 333. The peptide of the prior art is presumed to inherently have the surfactant activity because it is a structure falling within Applicants' claimed surfactant polypeptides and it is admixed with DPPC and DPPG.

A broad, yet reasonable, interpretation of claim 1 is that the claim encompasses peptides which are cyclic and which may contain D-amino acids. A claim is anticipated if even one species falling within said claim is found in the prior art, as is the case here.

This reference would anticipate Applicants' claimed subject matter under 35 U.S.C 102(a) if Applicants were entitled to the earliest effective filing date of 01-06-88. The reference would anticipate Applicant's claimed subject matter under 35 U.S.C. 102(b) if Applicant is not entitled to the filing date of the grandparent

application, Serial No. 07/141,200. According to 35 U.S.C. § 120, the invention disclosed in a Continuation must have met 35 U.S.C. § 112, first paragraph in the application previously filed (i.e. in the parent application) in order to benefit from the filing date. In order to satisfy this requirement, the specification of the parent, must among other things, 1) provide an enabling disclosure of the claimed subject matter of the continuing case and 2) must provide a written description of the claimed subject matter which is to receive priority. For the reasons set forth in paragraph 17 of the Office action mailed September 30, 1991, the claimed invention is not enabled or described by the specification.

There is no motivation provided by the reference to prepare longer polypeptides which have stretches of Leu and Lys. The reference does not teach or suggest that these compositions can be used in the claimed methods. Accordingly, all of the other claims of the instant application are free of this prior art reference.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Susan Perkins whose telephone number is (703)-308-1030. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)-308-0196.

S.M. Perkins
10-10-91

HOWARD E. SCHAIN
PATENT EXAMINER
GROUP 180-ART UNIT 1811

Howard E. Schain